

REMARKS/ARGUMENTS

The Examiner has delineated the following inventions as being patentably distinct:

Group I: Reagent H

Group II: Reagent E

Group III: Reagent L

Applicants provisionally elect with traverse Group I, reagent H, in view of the following arguments why all of the claims should be examined together.

There is a technical relationship that involves the same special feature, and it is this technical feature that defines the contribution which each of the groups, taken as a whole, make over the prior art.

The Office has failed to consider that there is indeed a common significant element that is shared by all of the claims, that is the attachment or self-organization of biological macromolecules with nanotubes of carbon which are functionalized by the physical adsorption of a reagent having the general formula H-E-L. In actuality the restriction is improper because reagent H-E-L must be viewed as a single entity and not be broken up into its component parts. The Examiner's attention is directed to Example 4 on page 18 of the specification wherein the reagent H-E-L (CR-174) is viewed as a whole and functions as such.

The Examiner's assertion that Claims 28-31 constitute a separate invention is somewhat misleading because Claims 28-31 are dependent on independent Claim 22, which defines the reagent H-E-L. In essence, Claim 22 is generic and its elements are sufficiently set forth.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusions with regard to patentable distinctness. M.P.E.P. § 803.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness. Rather the Office has merely stated conclusions. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement.

In chemical cases, a specified group of materials which do not necessarily belong to an otherwise class can be claimed together employing "Markush" language. The accepted expression for Markush grouping is "selected from the group consisting of". The Markush practice sanctions the claiming together operable substances which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The members of the Markush grouping need only possess at least one property in common which is mainly responsible for their function in the claimed relationship. In the instant application the common characteristic that exists is their use in the attachment or self-organization of biological macromolecules with nanotubes of carbon. The same utility in a generic sense suffices.

Further M.P.E.P § 803 states as follows:

"If a search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits even if it includes claims to distinct and independent inventions."

Applicants submit that a search of all claims would not constitute a serious burden on the Office. The Office has failed to provide any reason or examples to support a conclusion that the groups are patentably distinct. Applicants' election of Group I, reagent H, is for examination purposes only.

Finally, Applicants respectfully submit that should the elected invention be found allowable the Office should expand its search to the non-elected groups.

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Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

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